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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,389	08/05/2003	Tony Gichuhi	5348/55547	6519

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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/634,389	GICHUHI ET AL.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *RCE filed 10/23/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-10,17,19-28,30,31 and 33-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) *17,19-21,27,28,30 and 31* is/are allowed.

6)☒ Claim(s) *1, 8-10, 22, 24-26, 33-37, 40, 41* is/are rejected.

7)☐ Claim(s) *3,5-7,23,38 and 39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/17/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3, 5-10, 17, 19-28, 30, 31, and 33-41 are pending. Claims 2, 4, 11-16, 18, 29, and 32 have been canceled. Applicant's arguments and amendments filed 10/23/06 have been entered. Note that, with respect to the IDS filed 8/5/03, US patent 4,243,317 appears to be an incorrect listing in that the 1449 lists the patent to Grouke et al while the inventor is actually Garbe et al. Clarification with respect to this document is required.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/06 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to instant claims 40 and 41, the specification, as originally filed, provides no basis for "organic based coating" and "a polymer based coating" and "wherein the composition does not include an alkanolamine". Thus, this is deemed new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 7-10, 22, 24-26, 33-37, and 40 are rejected under 35 U.S.C. 103(a)) as being unpatentable over by Manabe et al (US 4,219,433) in view of Baseman (US 4,812,503), Kramer et al (US 5,519,074), and Gaglani (US 6,127,467).

Manabe et al teach metal corrosion inhibitor comprising benzoic acid, a trialkanolamine, phosphoric acid, and at least selected from mercaptobenzothiazole, etc., which exhibit excellent anti-corrosive property to various metals for a long term and can be diluted with an aqueous liquor and can be employed in combination with usual anti-freezing agents. See Abstract. The metal corrosion inhibitor of the invention may be employed in solid form and in that case, the inhibitor is added to cooling water as it is. The corrosion inhibitor may also be prepared to provide a commercially available liquid product. In that case, the inhibitor is dissolved in an appropriate amount of water. In the case of dissolving in water, the concentration is usually selected from 30 to 50% by weight. When the corrosion inhibitor is employed, it is desirable that the pH of the cooling water to which the inhibitor is added falls within the range of 6.5 to 9.5. In order to maintain the pH of the cooling water within 6.5 to 9.5, an appropriate basic material may also be added to the cooling water including sodium hydroxide, potassium hydroxide, etc. See column 3, line 55 to column 4, line 7.

Specifically, Manabe et al teach compositions in cooling water containing 4,000 ppm benzoic acid, 2500 ppm triethanolamine, 800 ppm trisodium phosphate, and 500 ppm of sodium salt of mercaptobenzothiazole. See column 5, lines 10-30. Sodium hydroxide was also added to these compositions to maintain the pH. See column 4, lines 40-69. Note that, with respect to instant claim 10, the Examiner asserts that the

triethanolamine and benzoic acid would react to form a stable aminocarboxylate salt because simple mixing of the triethanolamine and benzoic acid in water as taught by Manabe et al would allow this reaction to inherently occur. Additionally, the Examiner asserts that a component such as trisodium phosphate would also function as a pH adjusting agent due to its basic nature. Note that, with respect to process claims 22-24 and 36, the Examiner asserts that one of ordinary skill in the art would have been motivated to mix the ingredients in the order recited by the instant claims because Manabe et al teach mixing the ingredients and it is obvious to mix in any order. With respect to claim 31, this simply requires that the ingredients are mixed and then placed in another vessel for storage which is clearly suggested by Manabe et al because all cleaning compositions must be place in a vessel for storage.

Manabe et al do not teach the use of the composition in a paint or paint mixture composition or method of making a composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Baseman teach novel paint compositions comprising an organic solvent-based, organic solid film forming components and an organic volatile corrosion inhibitor. See Abstract.

Gaglani teaches corrosion inhibiting compositions and methods for applying these compositions to metal surfaces so as to inhibit reusing and formation of blisters wherein the compositions comprise at least one aminocarboxylate salt, a pigment, a

binder, and a solvent. See Abstract. These corrosion inhibitors may be incorporated into paint formulations. See column 1, lines 50-60.

Kramer et al teaches corrosion inhibiting compositions and the use of these corrosion inhibiting compositions in paint systems. See column 1, lines 5-40.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the corrosion inhibitors as taught by Manabe et al in paint compositions, with a reasonable expectation of success, because Baseman, Gaglani, and Kramer et al teach the use of corrosion inhibiting compositions in paint compositions compositions, and further, the use of corrosion inhibiting composition would be desirable to prevent corrosion of metal surfaces to which the paint is applied.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a paint composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Manabe et al in combination with Baseman, Gaglani, and Kramer et al suggest a composition and method of making a composition using the specific steps containing paint, water, an amine, carboxylic acid, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Claim 1, 7, 8, 10, 22, 24, 26, 33-37, and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 020,042 in view of Baseman (US 4,812,503), Kramer et al (US 5,519,074), and Gaglani (US 6,127,467).

'042 teaches a non-petroleum based metal corrosion inhibitor in the form of a solution of compounds mixed together in particular proportions to form a non-petroleum based coating for preventing, or inhibiting, the oxidation of metals. The solution is prepared from aliphatic monobasic acids, aromatic acids, amines, and water, with or without a lubricant. See Abstract. Generally, the sequence of addition of the various components appears to be important to get a finished product which is clear, stable and which can be diluted to produce a stable product. The mixture of the acid component and lubricant are added to water with stirring in a suitable mixing device. This is ifollowed by the addition of the aminoalkylalkanolamine. See page 8, lines 1-15.

Specifically, '042 teaches a compositions containing 12-18% containing 60% tall oil fatty acids and 40% rosin; 2 to 4% 100 SSU petroleum oil, 5 to 10% of an amine mixture containing 10% morpholine, 10 to 20% benzoic acid, and 48 to 71% water. See page 16, lines 1-15. Additionally, other examples show the use of triethanolamine. See page 19, lines 5-15. Note that, with respect to instant claim 10, the Examiner asserts that the morpholine or triethanolamine and benzoic acid would react to form a stable aminocarboxylate salt because simple mixing of the morpholine or triethanolamine and benzoic acid in water as taught by '042 et al would allow this reaction to occur. Note that, with respect to process claims 22-24 and 36, the Examiner asserts that one of ordinary skill in the art would have been motivated to mix the ingredients in the order recited by the instant claims because '042 teaches mixing the ingredients and it is obvious to mix in any order.

'042 does not teach the use of the composition in a paint or paint mixture composition or method of making a composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Baseman, Gaglani, Kramer et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the corrosion inhibitors as taught by '042 in paint compositions, with a reasonable expectation of success, because Baseman, Gaglani, and Kramer et al teach the use of corrosion inhibiting compositions in paint compositions compositions, and further, the use of corrosion inhibiting composition would be desirable to prevent corrosion of metal surfaces to which the paint is applied.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a paint composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '042 in combination with Baseman, Gaglani, and Kramer et al suggest a paint composition and method of making a paint composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 7-10, 22, 24, 25, 26, 33-37, 40, and 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 and 22-29 of copending Application No. 10/832139 in view of EP 020042. Claims 1-17 and 22-29 of 10/832139 encompass all the material limitations of the instant claims except for the inclusion of an alkyl amine.

'042 is relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use morpholine in the composition claimed by '139, with a reasonable expectation of success, because '042 teaches the use of morpholine in a similar corrosion inhibiting composition and further, '139 claims the use of amines in general.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable

expectation of success, because claims 1-17 and 22-29 of 10/832139 in combination with EP 020042 suggest a composition and method of making a composition using the specific steps containing water, an amine, carboxylic acid, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 17, 19, 20, 21, 27, 28, 30, and 31 allowed.

None of the references of record, alone or in combination, teach or suggest a paint composition containing a first complexing agent that comprises a specific amine group and a second complexing agent that comprises a carboxylic acid.

Claims 3, 5, 6, 7, 23, 38, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references of record, alone or in combination, teach or suggest a paint composition containing a first complexing agent that comprises a specific amine group and a second complexing agent that comprises a carboxylic acid.

Response to Arguments

Note that, Applicant's arguments with respect to the prior art rejections are moot since all previous prior art rejections based on 35 USC 102 or 103 have been withdrawn and a new grounds of rejection has been made as set forth above. Note that, with

respect to the double patenting rejection, Applicant states that claims 1-17 and 22-29 of 10/832,139 do not recite alkylamines and require a hydrotalcite which is not recited by the instant claims. In response, note that, '042 has been relied upon for alkylamines and has been combined with 10/832139. Furthermore, the instant claims recite comprising which would not exclude the presence of hydrotalcite.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
January 8, 2007